

**REMARKS**

The reconsideration and allowance of presently solicited Claim 1 to 10 respectfully is requested. Claims 6 to 10 are newly added and are directed to preferred embodiments of Applicants' contribution.

Applicants have provided a specifically defined solid electrolyte and a battery employing such solid electrolyte, and more particularly to a solid electrolyte with improved ionic conductivity and electrochemical stability and a lithium battery and a thin-film battery that employ the same.

The continued rejection of presently solicited Claims 1, 4 and 5 as being anticipated under 35 U.S.C. § 102(b) over the different teachings of U.S. Patent No. 4,906,537 to Hotomi et al. would be inappropriate. The  $\text{Li}_{3.6}\text{Si}_{0.6}\text{P}_{0.4}\text{O}_4$  teachings of Hotomi et al. specify a different layer than that presently claimed.

The continued rejection of presently solicited Claims 1, 4 and 5 as being anticipated under 35 U.S.C. § 102(b) by the different teachings of U.S. Patent No. 4,645,726 to Hiratani et al. would be similarly inappropriate. Here too the  $\text{Li}_{3.6}\text{Si}_{0.6}\text{P}_{0.4}\text{O}_4$  teachings of Hiratani et al. specify a different layer than that presently claimed.

Likewise the continued rejection of presently solicited Claims 1, 4 and 5 as being anticipated under 35 U.S.C. § 102(b) by the different teachings of U.S. Patent No. 4,572,873 or No. 4,555,456 both to Kanehori et al. would be similarly inappropriate. The  $\text{Li}_{3.6}\text{Si}_{0.6}\text{P}_{0.4}\text{O}_4$  film of Kanehori et al. is different than that claimed in Applicants' presently solicited claims.

Finally, the continued rejection of presently solicited Claims 2 and 3 as being anticipated under 35 U.S.C. § 102(b) over the different teachings of U.S. Reissue

Patent No. 34,469 to Cogan et al. would be inappropriate. These presently solicited claims employ "consisting essentially of" terminology with respect to the reactants utilized to form the solid electrolyte. The teachings of Cogan et al. at Col. 6, lines 29 to 60, have been carefully reviewed. In all instances Cogan et al. requires a mixture of  $\text{Li}_2\text{O}$ ,  $\text{ZrO}_2$  and  $\text{SiO}_2$ . The utilization of  $\text{ZrO}_2$  would change the basic character of the resulting solid electrolyte and render the technology of Cogan et al. outside Applicants' presently solicited claims which utilize "consisting essentially of" terminology. Applicants' specifically claimed contribution is outside the reasonably derived teachings of Cogan et al. and is neither disclosed nor remotely suggested upon a thorough reading of the reference teachings.

It is well established law that patentability is negated under 35 U.S.C. § 102 only when the prior disclosure is identical to the invention sought to be patented. Each and every element of the claimed invention must be disclosed in a single reference in complete detail. See Akzo N.V. v. United States ITC, 808 F.2d 1471, 1 U.S.P.Q.2d 1241 (Fed. Cir. 1986); Orthokinetics, Inc. v. Safety Travel Chairs, Inc., 806 F.2d 1565, 1 U.S.P.Q.2d 1081 (Fed. Cir. 1986); Rolls-Royce Ltd. V. GTE Valeron Corp., 800 F.2d 1101, 231 U.S.P.Q. 185 (Fed. Cir. 1986); Kloster Speedsteel AB v. Crucible Inc., 793 F.2d 1565, 230 U.S.P.Q. 81 (Fed. Cir. 1986); Great Northern Corp. v. Davir Core & Pad Co., 782 F.2d 159, 228 U.S.P.Q. 356 (Fed. Cir. 1986); In re Donohue, 766 F.2d 531, 226 U.S.P.Q. 619 (Fed. Cir. 1985); W.L. Gore & Assoc. v. Garlock, Inc., 721 F.2d 1540, 220 U.S.P.Q. 303 (Fed. Cir. 1983); SSIH Equip. S.A. v. United States ITC, 713 F.2d 746, 218 U.S.P.Q. 678 (Fed. Cir. 1983); and Richardson v. Suzuki Morot Co., 868 F.2d 1226, 9 U.S.P.Q.2d 1913

(Fed Cir. 1989). The withdrawal of each of the rejections is in order and respectfully is requested.

If there is any remaining point that requires clarification prior to the allowance of the Application, the Examiner is urged to telephone the undersigned attorney so that the matter can be discussed and resolved.

Respectfully submitted,

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FROM BURNS DOANE SWECKER & MATHIS)

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